REMARKS

Reconsideration is respectfully requested.

Claims 1 through 40 remain in this application. No claims have been cancelled or withdrawn. Claims 41 and 42 have been added.

Paragraphs 1 through 3 of the Office Action

Claims 1 through 18, 20 through 37, 39 and 40 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Nakabayashi et al (5,905,866) in view of Menezes et al. (5,437,691).

Claims 19 and 38 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Nakabayashi et al (5,905,866) in view of Menezes et al. (5,437,691), further in view of Nakabayashi et al (5,905,866).

Claims 1, 12, 23, and 26 each define a method including, in part, "receiving a file on the client computer, wherein the file is written in a source format *unreadable by the client computer*". Similarly, but not identically, claims 34, 39 and 40 each define a method including "receiving a file on the client computer, wherein the received file is written in a format *unreadable by the client computer*".

The text of the Office Action is silent regarding the requirement of the receiving step that the file that is received is "unreadable by the client computer", and does not specifically point to any portion of the Nakabayashi patent that is alleged to teach this aspect of the claimed invention. If fact, it is submitted that the Nakabayashi patent does not disclose the receipt of a file that is unreadable source format, and to the contrary, it is submitted that the Nakabayashi patent to be more likely to lead one of ordinary skill in the art to believe that the files received are readable by the system.

In particular, the Office Action refers to the text of the Nakabayashi patent at col. 12, lines 36 through 52, where it states (emphasis added):

> When receiving a requirement from one of the requiring elements 100f to 100i of the access management unit 100, for example, `transfer the title number 1 on X menu in Y service`, the communication control unit 300 translates the requirement to a menu number or command in the corresponding service of the communications host and sends the translated menu number or command to the communication I/F unit 500. When receiving data transmitted from the communications host via the communication I/F unit 500, on the other hand, the communication control unit 300 extracts a required portion from the input data, converts the portion into a form required by the access management unit 100, and transfers the converted data to the access management unit 100. The communication I/F unit 500 sends and receives data to and from the communications host connected thereto through a communication line via the modem 92.

It is submitted that the referenced portion of the Nakabayashi patent indicates to one of ordinary skill in the art that the data received by the Nakabayashi system is in a form that is in fact "readable" by the system, as the Nakabayashi patent discusses the "extraction" of a portion of the data from the overall data received, and this data portion is converted. It should be noted that the elements involved in this extraction and conversion--namely--access management unit 100, communication control unit 300, and communication I/F unit 500--are all elements of the same "communications terminal" as shown in Figure 1 and is described at col. 7, lines 28 through 30.

It is noted that the Nakabayashi patent further describes a step of "extracting title data from the transmitted data" in the description of the process of the system, particularly at col. 18, lines 49 through 4 (emphasis added):

> A command is then transmitted to read all unread titles at step S22. In accordance with a concrete procedure, the access management unit 100 transmits a command to the communications host via the communication control unit 300, in order to read only the unread titles

> among all the titles of discussion. The communications host stores and manages unread title numbers for the respective discussion groups. In response to the command, the communications host transmits all the titles corresponding to the unread title numbers to the user. In this manner, the communications host transmits data on the unread titles. The communications terminal receives the transmitted data at step S24, extracts each title data from the transmitted data at step S26, and writes the extracted title data in the index file regarding the selected discussion group at step S28. In accordance with a concrete procedure, the communication control unit 300 receives the transmitted data via the communication I/F unit 500, extracts each title data from the transmitted data, and transfers the extracted title data to the access management unit 100. The access management unit 100 then writes the title data into the index file `mes*.idx` in the database 410 via the data management unit 400. This terminates the series of title updating operation.

This step of reading files is also referenced in several of the Figures of the drawings of the Nakabayashi patent, particularly, step "S26" and "S34" of Figures 8 and 9, respectively. This discussion strongly suggests that the data received by the Nakabayashi system is *not* in a file format that is "unreadable" by the system, as that would make it impossible to read and extract any title data from the received data.

It is therefore submitted that the Nakabayashi patent does not disclose the claim requirement of "receiving a file on the client computer, wherein the file is written in a source format *unreadable by the client computer*", and would not lead one of ordinary skill in the art to this requirement of claims 1, 12, 23, 26, 34, 39, and 40.

Turning to the other patent of the allegedly obvious combination, the Menezes patent, it is noted that the Menezes patent generally discusses the communication of capabilities between devices so that a transmitting device does not send data to a receiving device in a format or manner that the receiving device is not capable of handling. Most importantly, if the transmitting device (upon checking its data on the capabilities of the receiving device) recognizes that the receiving device is incapable of

handling the data in the format that the transmitting device has the information, the data is converted to a form compatible to the capabilities of the receiving device *before* the transmitting device transmit the data to the receiving device. In other words, the reception of data by the receiving device in a format incompatible with its capabilities is *prevented* by converting the data before the data is even transmitted by the transmitting device to the receiving device. Thus, it is submitted that the Menezes patent could only lead one of ordinary skill in the art away from the requirement of "receiving a file on the client computer, wherein the file is written in a source format *unreadable by the client computer*", as it is clear to one of ordinary skill in the art that the Menezes expressly prevents such an occurrence by only transmitting data to a receiving device that the receiving device is capable of handling.

In greater detail, it is noted that the referenced portion of the Menezes patent states, at col. 6, 25 through 41 (emphasis added):

> The system 10 also contains a custom mode storage area 26 which stores the custom data processing capabilities of the system. An application mode storage area 28 stores a list of application data processing capabilities of the system 10. A capabilities cache 30 stores lists of custom and application capabilities received from other systems of the present design. The capabilities cache 30 also stores a data code associated with the capabilities for each specific receiving FAX machine which is used to indicate whether the stored list accurately reflects the current capabilities of the receiving FAX machine. As will be explained below, the list of stored capabilities can be used for future communication between two systems of the present design. A conversion processor 32 processes a data file into the desired form for data transfer. Operation of the conversion processor 32 to convert a data file from one form to another is well known in the art and will not be described in detail.

Thus, the Menezes system involves the transmission and storage of capability information for each of the FAX machines on another FAX machine, so that a transmitting FAX machine is aware of the capabilities of the receiving FAX machine to which it is transmitting data, and the transmitting FAX machine can thus adjust the characteristics of the FAX

transmission so as not to violate the capabilities of the receiving FAX machine. See, also col. 7, lines 10 through 20 (emphasis added):

> The following description of operation of the system 10 shown in the flow charts of FIGS. 3 and 4 relate to a FAX machine, however, it should be appreciated that the principles of the present invention are not limited to FAX machines. The flow charts of FIGS. 3 and 4 are from the perspective of the transmitting FAX machine. The transmitting FAX machine determines the transfer form based on the data processing capabilities of the transmitting and receiving FAX machines. Alternatively, the receiving FAX machine could specify the desired transfer form based on the final data form desired by the receiving FAX machine.

Thus, because the transmitting FAX machine is aware of the capabilities of the transmitting FAX machine, the data to be transmitted is converted to a "mutually compatible data form for transfer" (see, e.g., Figure 4 of Menezes) *before* being transmitted from the transmitting FAX machine to the receiving FAX machine, and therefore the receiving FAX machine is *never* sent an "unreadable" FAX transmission due to an incompatible file format.

This is further confirmed by the statement in Menezes at col. 9, lines 11 through 7, where it states (emphasis added):

> In step 122, the system 10 determines the most efficient mutually compatible data form for transfer to the receiving FAX machine. The system selects the mutually compatible data form using the application capabilities list transferred in step 118 or loaded from the capabilities cache 30 (see FIG. 2) in step 112, the custom capabilities list exchanged in step 102, or the CCITT encoding formats (MH, MR, or MMR) exchanged in step 104.

It is therefore submitted that one of ordinary skill in the art, considering the discussion in Menezes, would not be led to the requirement of claim 1 of "receiving a file on the client computer, wherein the file is written in a source format unreadable by the client computer", since the primary object of the Menezes system is to avoid sending a FAX transmission in an incompatible format to the receiving FAX machine.

Thus, since neither the Nakabayashi nor the Menezes patents disclose the requirement of "receiving a file on the client computer, wherein the file is written in a source format *unreadable by the client computer*", it is submitted that the allegedly obvious combination of these patents could not lead one of ordinary skill in the art to the requirements of the claims.

Withdrawal of the §103(a) rejections of claims 1 through 40 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.

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Jeffrey A. Proehl (Reg. No. 35,987)
LEONARD & PROEHL, Prof. L.L.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5807
(605)339-2028 FAX (605)336-1931